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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,760	05/18/2006	Makoto Yoshida	SH-0053PCT/US	3570
21254 7590 05/06/2010 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER DEHGHAN, QUEENIE S				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,760

Applicant(s)

YOSHIDA, MAKOTO

Examiner

QUEENIE DEHGHAN

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-10 and 12-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claim 2 recites wherein in the predetermined period is no less than 3 seconds and no more than 60 seconds. Claim 2 refers to claim 1 for the basis for "predetermined period". It appears claim 1 indicates the relative reciprocation is stopped in a predetermined period. In other words the movement will stop after moving for a length of time, which is interpreted to be the "predetermined period". However, the predetermined period of between 3 and 60 seconds as recited in claim 2 is not supported in the specification. What is supported is a stopping period of between 3 and 60 seconds. The predetermined period as provided for in claim 1 is not the same as the stopping period because "*in a predetermined period*" means stopping will occur *after a length of time* (i.e. in 1 minute), whereas "*for a predetermined period*" would indicate

that stopping is performed for a length of time. Similarly, the argument holds for claims 3-10 and 12-19, which also recite the term "predetermined period". If the Examiner has erred in finding lack of support in the specification, please list the page and line number where support can be found.

5. Claims 7-10 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 7-10 and 19 recite *a period* in which said burner stops is extended. It appears "a period" is defined as a time when the burner stops, which is similar to the stopping step of independent claim 1. It is unclear if this period is the same or different from the predetermined period as recited in claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ooishi et al. (2002/0073737). Ooishi teaches a method for manufacturing an optical fiber base material comprising depositing by OVD glass particles on a starting rod while relatively reciprocating the burner and starting rod and stopping the reciprocating in a predetermined period only at turning positions of the relative reciprocation ([0070]-[0071]). The period in which the stopping occurs is calculated as follows:

Traversing length = 200mm

Traveling speed = 740mm/min or 12.3mm/sec

Traveling period before turning around = $200/12.3 = 16.3$ seconds.

9. Claims 11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication US2002/0062666, Ooishi et al. ('Ooishi' hereinafter). Ooishi teaches an optical fiber base material which is made via an outside vapor deposition process (paragraph [0002], Fig. 1). The examiner notes both claim 11 and 20 are product by process claims, which are not limited to the manipulations of the recited steps, only the structure; therefore, since the method of claim 2 does not provide any additional structure to an optical fiber base material produced by the method of claim 1, the optical fiber base material of claim 20 which relies on the method of claim 2 is fully anticipated by Ooishi.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ooishi as applied to claims 1 and 2 above in view of Japanese Patent Application Publication JP2000-256034, Yasumoto et al., ('Yasumoto' hereinafter). Ooishi teaches the method of claim 1 and 2 as detailed above.

Ooishi does not expressly disclose wherein in the predetermined period during the relative reciprocation, combustion gas is decreased.

Yasumoto discloses a closely related invention of a method of manufacturing optical fiber base material employing the OVD process, in which a burner is relatively reciprocated against and along an initial material to deposit glass fine particles on said initial material to produce an optical fiber base material, comprising steps of: relatively reciprocating said burner and said initial material (Abstract; Fig. 1) wherein during the relative reciprocation, combustion gas is decreased (paragraph [0004]).

It would be obvious to one of ordinary skill in the art at the time the invention was made to include the decrease in combustion gas of Yasumoto in the predetermined period of Ooishi. The motivation is the rationale provided by Yasumoto in that adjusting the flow rate of the combustion gas allows soot density to be made uniform, a lowering in surface cracks, and suppression of the fluctuation in the outside diameter of a soot preform (Abstract).

12. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ooishi as applied to claims 1 and 2 above in view of US Patent Application Publication US2003/0070450, Nakamura et al., ('Nakamura' hereinafter).

Ooishi teaches the method of claim 1 and 2 as detailed above.

Ooishi does not expressly disclose wherein in the stopping period during the relative reciprocation, the amount of material gas is increased.

Nakamura discloses a closely related invention of a method of manufacturing optical fiber base material employing the OVD process, in which a burner is relatively

reciprocated against and along an initial material to deposit glass fine particles on said initial material to produce an optical fiber base material, comprising steps of: relatively reciprocating said burner and said initial material (Abstract) and wherein during the relative reciprocation, the amount of material gas is increased (paragraph [0026]).

It would be obvious to one of ordinary skill in the art at the time the invention was made to include the increase of material gas of Nakamura in the predetermined period of Ooishi. The motivation is the rationale provided by Nakamura in that increasing the amount of material gas causes a longer effective portion length (of a soot body) and a shorter ineffective portion length (of a soot body) (paragraph [0035]).

13. Claims 5-10, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ooishi as applied to claims 1 and 2 above in view of Japanese Application Publication JP09-278477, Sayaka, ('Sayaka' hereinafter).

Ooishi teaches the method of claim 1 and 2 as detailed above.

As for claim 5-7, 9, 15, 17 and 19, Ooishi does not expressly disclose changing the predetermined period during the relative reciprocation continuously or step by step depending on a deposition period, a deposition weight, or the number of relative reciprocation. Ooishi also does not expressly disclose extending the burner stop period. Sayaka teaches a closely related invention of a method of manufacturing optical fiber base material employing the OVD process, in which a burner is relatively reciprocated against and along an initial material to deposit glass fine particles on said initial material to produce an optical fiber base material, comprising steps of: relatively reciprocating said burner and said initial material (Abstract; fig 1) and wherein the deposition weight is

primarily set as a condition, and a speed of the burner during the relative reciprocation is changed continuously depending on said determined condition (paragraph [0005-0006]); wherein the deposition weight is primarily set as a condition, and a speed of the burner during the relative reciprocation is changed step-by-step depending on said determined condition (paragraph [0005-0006]); wherein if the diameter of said optical fiber base material increases, said certain period in which said burner remains at a location of the initial material is extended (paragraph [0005-0006]); wherein if said deposition weight increases, said certain period, in which said burner remains at a location of the initial material, is extended (paragraph [0005-0006]).

The limitation of claims 5-7, 9, 15, 17 and 19 recite that the predetermined period is changed or that the certain period in which said burner stops is extended; thus allowing the burner to stay at a location along the starting material for an extended or shortened period of time.

Although Sayaka does not expressly disclose that the burner is stopped for a stopping period, Sayaka does teach that a speed of the burner slows or is changed continuously and step-by-step (stage-by-stage) along a length of the starting material based on an increase in a diameter or weight of the optical fiber base material (paragraph [0005-0006]); therefore allowing the burner to stay at a location along the starting material for an extended or shortened period. Thus, Sayaka teaches the same function of the limitations of claims 5-7, 9, 15 and 19.

It would be obvious to one of ordinary skill in the art at the time the invention was made to include the teachings of Sayaka with the method of Ooishi such that wherein

one of the deposition period, the deposition weight, or the number of relative reciprocation is primarily set as a condition, the predetermined period during the relative reciprocation may be changed continuously depending on said determined condition; wherein one of the deposition period, the deposition weight, or the number of relative reciprocation is primarily set as a condition, the predetermined period during the relative reciprocation may be changed step-by-step depending on said determined condition; wherein if the diameter of said optical fiber base material increases, a period in which said burner stops may be extended; wherein if said deposition weight increases, a period in which said burner stops, may be extended. The motivation to include the teachings of Sayaka with Ooishi is the rationale provided by Sayaka in that allowing for the burner to stay at a location along the starting material for an extended or shortened period of time based on diameter and weight changes suppresses the fluctuation in the outside diameter of the initial material(Abstract; paragraph [0005-0006]).

As for claims 8 and 10, Ooishi and Sayaka combine to teach the method of claim 7 as detailed above.

Neither Ooishi nor Sayaka expressly disclose wherein if said deposition period increases, said certain period, in which said burner stops, is extended; wherein if the number of relative reciprocation increases, said certain period, in which said burner stops, is extended.

It is known in the art that there is a long felt need to overcome the issue of soot uniformity such that the diameter of a sooty body is uniform in the longitudinal direction as referenced by Ooishi (paragraph [0002], [0006]). Ooishi teaches the importance of

determining the scheduling for depositing the glass particles so that the turning positions are distributed uniformly over the whole length of the fiber base material.

It would be obvious to one of ordinary skill in the art at the time the invention was made to extend said certain period in which said burner stops if said deposition period increases or if the number of relative reciprocation increases. If the deposition period or relative reciprocation increases over the initial material, the outer diameter of the base material may differ in the amount of soot deposited in one area versus another.

Therefore it would be obvious to extend the certain period in which the burner stops over a given portion having a smaller diameter to correct for fluctuations in diameter.

The motivation to correct for diameter fluctuation is the rationale provided by Ooishi in that to obtain an optical fiber preform of good quality, it is important to reduce the fluctuation of the outer diameter of a soot body as much as possible (paragraph [0006]).

14. Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ooishi in view of Yasumoto as applied to claim 3, and further in view of Nakamura (US2003/0070450).

Ooishi and Yasumoto combine to teach the method of claim 3 as detailed above.

Neither Ooishi nor Yasumoto expressly disclose wherein in the stopping period during the relative reciprocation, the amount of material gas is increased.

Nakamura discloses a closely related invention of a method of manufacturing optical fiber base material employing the OVD process, in which a burner is relatively reciprocated against and along an initial material to deposit glass fine particles on said initial material to produce an optical fiber base material, comprising steps of: relatively

reciprocating said burner and said initial material (Abstract) and wherein during the relative reciprocation, the amount of material gas is increased (paragraph [0026]).

It would be obvious to one of ordinary skill in the art at the time the invention was made to include the increase of material gas of Nakamura with the predetermined period of Ooishi. The motivation is the rationale provided by Nakamura in that increasing the amount of material gas causes a longer effective portion length (of a soot body) and a shorter ineffective portion length (of a soot body) (paragraph [0035]).

15. Claim 16 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Ooishi in view of Yasumoto as applied to claim 3 above, and further in view of Sayaka (JP09-278477).

Ooishi and Yasumoto combine to teach the method of claim 3 as detailed above.

Neither Ooishi nor Yasumoto expressly disclose changing the predetermined period during the relative reciprocation continuously or step by step depending on a deposition period, a deposition weight, or the number of relative reciprocation.

Sayaka teaches a closely related invention of a method of manufacturing optical fiber base material employing the OVD process, in which a burner is relatively reciprocated against and along an initial material to deposit glass fine particles on said initial material to produce an optical fiber base material, comprising steps of: relatively reciprocating said burner and said initial material (Abstract; fig 1) and wherein the deposition weight is primarily set as a condition, and a speed of the burner during the relative reciprocation is changed continuously depending on said determined condition (paragraph [0005-0006]); wherein the deposition weight is primarily set as a condition,

and a speed of the burner during the relative reciprocation is changed step-by-step depending on said determined condition (paragraph [0005-0006]).

The limitation of claims 16 and 18 recite that the predetermined period is changed; thus allowing the burner to stay at a location along the starting material for an extended or shortened period of time.

Although Sayaka does not expressly disclose that the burner is stopped for a stopping period, Sayaka does teach that a speed of the burner is changed continuously and step-by-step (stage-by-stage) along a length of the starting material based on an increase in a diameter or weight of the optical fiber base material (paragraph [0005-0006]); therefore allowing the burner to stay at a location along the starting material for an extended or shortened period. Thus, Sayaka teaches the same function of the limitations of claims 16 and 18.

It would be obvious to one of ordinary skill in the art at the time the invention was made to include the teachings of Sayaka with the method of Ooishi such that wherein one of the deposition period, the deposition weight, or the number of relative reciprocation is primarily set as a condition, the predetermined period during the relative reciprocation may be changed continuously depending on said determined condition; wherein one of the deposition period, the deposition weight, or the number of relative reciprocation is primarily set as a condition, the predetermined period during the relative reciprocation may be changed step-by-step depending on said determined condition; The motivation to include the teachings of Sayaka with Ooishi is the rationale provided by Sayaka in that allowing for the burner to stay at a location along the starting material

for an extended or shortened period of time based on diameter and weight changes suppresses the fluctuation in the outside diameter of the initial material (Abstract; paragraph [0005-0006]).

Response to Arguments

16. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. The Ooishi reference numbered US2002/0062666 does not teach stopping the relative reciprocation at turning points *only*. However, a new rejection under Ooishi reference number US2002/0073737 is presented. The applicant's arguments regarding the secondary references of Yasumoto, Nakamura and Sayaka refers only to the newly amended claim limitations of "stopping the relative reciprocation in a predetermined period only at turning positions", which has been addressed by the new reference.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Queenie Dehghan whose telephone number is (571)272-8209. The examiner can normally be reached on M-F, 9-5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Queenie Dehghan/
Examiner, Art Unit 1791